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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/497,552	02/03/2000	Guido Maurizio Oliva	3572-15	7648

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EXAMINER

LESTER, EVELYN A

ART UNIT PAPER NUMBER

2873

DATE MAILED: 04/19/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/497,552

Applicant(s)

OLIVIA

Examiner

Evelyn A. Lester

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 December 2004.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2 and 4-39 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 17-21,23-25 and 28 is/are allowed.
- 6) ☒ Claim(s) 1,2,4-8,11-16,22,27,29 and 32-39 is/are rejected.
- 7) ☒ Claim(s) 9,10,30 and 31 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 03 February 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 12-15-04 has been entered.

Allowable Subject Matter

2. The indicated allowability of claims 6-8, 16, 22 and 27 is withdrawn in view of the newly discovered reference(s) to Forbes et al (U.S. Patent 5,717,194). Rejections based on the newly cited reference(s) follow.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 32-37 and new claim 38 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s)

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contains subject matter, which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

There is no disclosure for the claimed invention to have a "...first means arranged beyond an outer edge of the focusing lens..." or "...said first means and said focusing lens being distinct from one another and being arranged in said single optical element such that they are never adjacent..." . In fact the entire disclosure for the Applicant's invention appears to teach away from this very recitation, in that the first means is directly applied on the focusing lens to form a single optical element, thereby to provide a constructively simple, small dimensioned and inexpensive element and/or device in which it is utilized.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 32 and 34 are rejected under 35 U.S.C. 102(b) as being anticipated by Metlitsky (U.S. Patent 5,233,170).

Metlitsky et al disclose an optical device for focusing a laser beam, comprising a focusing lens (34) and a first means (36) arranged beyond an outer edge of the focusing

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lens, adapted to separate a central portion of the laser beam from a surrounding portion of the laser beam, wherein the entire portion of the laser beam collected by the focusing lens is focused. Please note, for example, Figure 6.

5. Claims 1, 2, 4-8, 11-16, 22, 26, 27, 29, 32-37, 38 and 39 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Forbes et al (U.S. patent 5,717,194).

Forbes et al disclose the claimed invention of an optical device for focusing a laser beam, comprising a focusing lens (24) and a first means (10,14) arranged beyond an outer edge of the focusing lens, adapted to separate a central portion of the laser beam from a surrounding portion of the laser beam, wherein the entire portion of the laser beam collected by the focusing lens is focused. Please note, for example, Figure 1 and the text at column 2, lines 18-33; also at Figures 11-14 and their accompanying text at column 4, lines 10-18.

With respect to the alignment means or container, please note element 40 in Forbes et al.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ

645 (Fed. Cir. 1985); In re Van Ornum, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); In re Vogel, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, In re Thorington, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

6. Claims 1, 2, 4, 5, 11-15, 26, 29 and 32-36 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 6-14 and 17 of copending Application No. 09/773,384 (which is also published application number US 2002/0050517 A1, filed on February 1, 2001).

Although the conflicting claims are not identical, they are not patentably distinct from each other because each claimed invention of the applications is merely a variation of the other, wherein one invention would anticipate the other.

Each claimed invention recites an optical device, wherein a laser light beam is focused by a focusing lens and a first means or a diaphragm, directly on the focusing lens (claim 1 of the instant invention and claim 13 of the other application's claimed

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invention) which selects only a central portion of the laser beam, and further wherein the first means or diaphragm defines an aperture having a Fresnel number less than 2.

The copending application's claimed invention further describes a source of a laser light beam. However, this is inherent to the present claimed invention, which claims a laser beam. One of ordinary skill in the art would know to provide a source of laser light to provide the appropriate laser beam for the claimed optical device.

This is a **provisional** obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Allowable Subject Matter

7. Claims 9, 10, 30 and 31 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

8. Claims 17-21, 23-25 and 28 are allowed.

9. The following is a statement of reasons for the indication of allowable subject matter:

The prior art does not show or fairly suggest the claimed subject matter and the claimed invention of an optical device having the claimed structure and claimed limitations, wherein a rejection under 35 USC 102 or 103 would be improper. Please

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particularly note the combination of claimed elements and claimed limitations, including as recited in claim 17, the focusing lens having a substantially tubular portion of lens which extends from the front surface of the focusing lens and is adapted to be mounted by interference on a support structure for the source of emission and the tubular portion having an inner wall provided with at least one tooth extended in a substantially radial direction and adapted to be housed into a corresponding housing obtained on the support structure of the source of emission; as recited in claim 21, wherein the means for allowing the optical alignment between the source of emission and the focusing lens has at least two strips which extend from the front surface of the lens and are adapted to be mounted by interference on a support structure of the source of emission; as recited in claim 23, the optical alignment means having a tubular container housing wherein the focusing lens has a reference notch intended for being positioned in alignment with the visual reference marked on the container; as recited in claim 25, wherein the container has an internal guide adapted to cooperate with an alignment slot formed on the focusing lens; and as recited in claim 28, wherein the first means is directly and integrally applied on the focusing lens and defines on the focusing lens an aperture having a Fresnel number which is smaller than 2 along the fixed reading direction and the lens and diaphragm have opposed front surfaces with conjugated shape.

With respect to claims 9, 10, 30 and 31, please note the reasons for indicating allowable subject matter given in paper 18, mailed on 9-16-03.

Response to Arguments

10. Applicant's arguments filed 12-15-04 have been fully considered but they are not persuasive.

Applicant's arguments with respect to claims 32-37 have been considered but are moot in view of the new ground(s) of rejection.

Regarding the provisional obviousness-type double patenting rejection, this rejection is proper and hereby maintained. The application is not in condition for allowance, except for the obviousness-type double patenting rejection.

Conclusion

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Evelyn A. Lester whose telephone number is (571) 272-2332. The examiner can normally be reached on M- F, from about 10 am to 7 pm, subject to an increased flex schedule.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Georgia Y. Epps can be reached on (571) 272-2328. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Evelyn A. Lester
Primary Examiner
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